

REMARKS

Applicant is in receipt of the Office Action mailed April 21, 2011. Claims 1-73 and 76-104 were pending in the application, and were rejected. Reconsideration of the case is earnestly requested in light of the following remarks.

Section 112 Rejection

Claims 58, 89, 92 and 100 were rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. The Examiner stated that, "The omitted structural cooperative relationships are: related to not disclosing sufficient structure to support software-implemented means-plus-function claims. Recent case law has required specific algorithms to be disclosed." Applicant respectfully traverses this rejection. Taking claim 58 as an exemplary claim, the claim recites:

58. (Previously Presented) A computer based method for displaying patent marking information, the method comprising:

receiving user input to purchase one or more software products from an e-commerce server, wherein the user input is received over a network;

downloading the one or more software products to a computer system from the e-commerce server over the network;

retrieving patent marking information corresponding to each of said one or more software products based on the user input, wherein the patent marking information comprises information identifying patents that are applicable to technology of the one or more software products; and

displaying said patent marking information on a display device.

As recited in the claim, user input to purchase one or more software products from an e-commerce server is received over a network. The one or more software products are downloaded to a computer system from the e-commerce server over the network. Patent marking information corresponding to each of said one or more software products is retrieved based on the user input and displayed on a display device. Applicant respectfully submits that all of the elements of the claim are connected to each other in a logical way such that that there is no gap between the structural elements of the

claim. Accordingly, Applicant respectfully submits that claim 58 does particularly point out and distinctly claim the subject matter as required by the second paragraph of 35 U.S.C. 112, and respectfully requests removal of this rejection. Inasmuch as the other rejected claims 89, 92 and 100 recite similar subject matter as claim 58, Applicant respectfully submits that these claims also satisfy 35 U.S.C. 112, and respectfully requests removal of the rejection of these claims as well.

Section 103 Rejection

Claims 1-73 and 76-104 were rejected under 35 U.S.C. 103(a) as being unpatentable over Amro et al. (US Patent No. 6,948,169, hereinafter “Amro”) in view of Lee (US Patent App. Pub. No. 2002/0138297), further in view of Adobe® Acrobat® 5.0, Adobe PDFMaker Help (hereinafter “Adobe PDFMaker Help”), and further in view of Adobe® Acrobat® 5.0, Classroom in a Book (hereinafter “Classroom in a Book”). Applicant respectfully traverses this rejection.

The present application is directed to the problem of automatically informing a user of a computer system about patents applicable to technology used in resources of the computer system. Claim 1, for example, recites, “A computer-implemented method for displaying patent marking information, the method comprising...” and “displaying said patent marking information on a display device.” Applicant notes that neither Amro nor Lee is directed to the problem of displaying patent marking information. Amro relates to web-based factory manufacturing of computers in a build-to-order manufacturing environment. Nowhere in the disclosure does Amro mention the concept of patent marking information, or even mention any issues at all related to intellectual property. Lee relates generally to the field of intellectual property, but is directed to the problem of actively gathering intellectual property information for the purpose of legal analysis. (See the background section at paragraphs 0002-0005.) At paragraph 0026, Lee teaches that, “a user may search for a particular product in the product information 3, and following the link(s), determine the data record(s) 7 and thus the patents, if any, in the intellectual property information 1 relating to the product.” Thus, for example, an attorney or someone who needs to find the patents related to a product can actively perform a search, and the system will present a set of links that can be followed to the

patents. This type of active searching by someone who is gathering information for the purpose of performing a legal analysis is not at all the same as the problem of automatically informing a user of a computer system about patents applicable to technology used in resources of the computer system. Applicant respectfully submits that the Examiner has largely engaged in a hindsight analysis of the present claims by combining two references, neither of which is particularly related to the problem solved by the present claims, as well as being almost completely unrelated to each other. Applicant respectfully submits that the subject matter recited in the present claims would not be obvious in view of the cited art (particularly in view of Amro and Lee), taken either singly or in combination. Applicant thus respectfully submits that the claims are patentably distinct over the cited art for at least this reason.

Furthermore, even if the references could be combined, Applicant respectfully submits that they still do not teach the limitations of the claims. Claim 1, for example, recites, “retrieving, from a memory medium, patent marking information corresponding to each of said one or more resources based on said programmatically detecting, wherein the patent marking information comprises information identifying patents that are applicable to technology of the one or more resources”. As discussed above, Lee requires a user to manually search for the patents related to a particular product or item of trade (IOT), e.g., an IOT for which the user needs to perform a legal analysis. There is no teaching or suggestion in Lee or Amro, taken either singly or in combination, about retrieving patent marking information specifically for resources of a computer system based on programmatically detecting the resources of the computer system. Applicant thus respectfully submits that the claims are further patentably distinct over the cited art for at least this additional reason.

CONCLUSION

Applicant submits the application is in condition for allowance, and an early notice to that effect is requested.

If any extensions of time (under 37 C.F.R. § 1.136) are necessary to prevent the above-referenced application(s) from becoming abandoned, Applicant(s) hereby petition for such extensions. The Commissioner is hereby authorized to charge any fees which may be required or credit any overpayment to Meyertons, Hood, Kivlin, Kowert & Goetzel P.C., Deposit Account No. 50-1505/5150-64300/JCH.

Also filed herewith are the following items:

- ☐ Request for Continued Examination
- ☐ Terminal Disclaimer
- ☐ Power of Attorney By Assignee and Revocation of Previous Powers
- ☐ Notice of Change of Address
- ☐ Other:

Respectfully submitted,

/Jeffrey C. Hood/

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Date: 2011-07-21 JCH/JLB